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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,839	03/26/2004	Blayn W. Beenau	70655.0300	2838

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EXAMINER

WALSH, DANIEL I

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 05/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

H.A

Office Action Summary	Application No.		Applicant(s)	
	10/708,839		BEENAU ET AL.	
	Examiner		Art Unit	
	Daniel I. Walsh		2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Receipt is acknowledged of the Amendment received on 19 April 2006.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 21 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for primary and secondary association with one user, does not reasonably provide enablement for different users. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. The Examiner notes that the specification only discussed primary and secondary association with a single user, not different users, as claimed in claim 21. Further, how can one sample be associated with two users?

Appropriate clarification/correction is requested.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re claim 1, it is unclear to the Examiner how a biometric, which is associated with an account (understood to have a transaction limitation), can have the limitation be independent of any limitation associated with the account. For example, if the charge account has a credit limit, it is unclear how the limitation associated with the biometric can be independent of a credit limit of the card.

Re claim 21, it is unclear how different users would have primary and secondary association, as primary and secondary association appears to occur with a single user, otherwise it would just be separate associations, not primary/secondary. Additionally, how can one sample be from two users?

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was

made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-7, 9-16, and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Black (US 6,925,565) in view of Baer (US 2005/0232471).

Re claim 1, Black teaches receiving a proffered biometric sample at a sample receiver, receiving user information at said sample receiver; associating the biometric sample with the user information to create a data packet (FIG. 5A+, 4A, and abstract). The user information stored is interpreted as a data packet that associates user information, biometric information, and transponder information as the transponder has a unique customer number/serial number that is part of the record. Though Black is silent to receiving transponder information and associating it with the user information and biometric sample as part of the data packet, the Examiner notes that each transponder has an associated unique record/serial number. Such unique identifying means serve as a well know and conventional means to identify and provide security to the system. Accordingly, it would have been obvious to one of ordinary skill in the art to receive the unique identifier and associate it with the data packet as a means to identify and verify the authenticity of the device. Black is teaches associating the biometric sample being associated with at least one of a charge account, a credit card account, a debit card account, a savings account, a private label account, and a loyalty point account, as discussed above.

Black is silent to the sample being associated with a transaction limitation independent of a limitation associated with the account.

Baer teaches such limitations (paragraph [0037]).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black with those of Baer.

One would have been motivated to do this for different security levels.

Re claim 2, Black teaches contacting an authorized sample receiver through at least one of a computer Internet, software, hardware, third party biometric entity, kiosk, biometric registration terminal, and communication device (FIG. 1A). It is clear that during reception of the sample that the receiver is in contact with one of a computer, internet, software, hardware, biometric entity, kiosk, biometric registration terminal, and a communication device in order for the sample to be received and to facilitate the transaction.

Re claim 3, Black teaches the receiving of the sample includes at least one of processing storing, comparing, and verifying the sample as a record is created as discussed above. It would have been obvious to one of ordinary skill in the art to process/store/compare/verify the sample as such means are conventional in the art to authenticate a sample (that it is real), and put it into a format that can be recognized, and stored for accessing and verifying a user.

Re claim 4, it has been discussed above that the proffered biometric sample is associated with at least one of personal information, credit card information, debit card information, savings account information, and loyalty point information (FIG. 3).

Re claim 5, Black teaches (FIG. 1A) that the data can be stored on a host computer or on the transponder itself (col 4, lines 29+), where is interpreted as being contained in at least one of a transponder, transponder reader, sensor remote server, merchant server, and transponder-reader system. Though Black is silent to database, Black teaches that according to the desired security, information can be stored on the transponder itself or remotely. Therefore, it is well within the

skill in the art to store the data packet information at one of the locations set forth in the claim, depending on the desired type of security, using a database, which is a well known and conventional means to store and organize data.

Re claim 6, the Examiner notes that it is obvious that more than one sample can be registered, as the system is envisioned to be used with multiple users, hence multiple samples. Additionally, Baer, as discussed above, teaches multiple samples.

Re claim 7, the Examiner notes that though Black/Baer are silent, it would have been obvious to one of ordinary skill in the art that different samples (from different people) would be associated with different information from those others who are registered in the system.

Re claims 9-11, the limitations have been discussed above, where the Examiner notes it would have been obvious for different users to have different samples and information (unique users).

Re claim 12, it would have been obvious to one of ordinary skill in the art to use a secondary security feature to authenticate a user/sample. Such procedures are well known and conventional in the art, such as signatures, PIN, verifying that a sample is a real sample (from a living person, and examples include temperature and blood flow sensors). Such modification is an obvious expedient for security of the system.

Re claim 13, Black teaches that a unique identifier/customer number is associated with the user (FIG. 10A+). This is broadly interpreted as a personal identification number, or a unique means to verify a user/device. Additionally, the Examiner notes PIN-biometric combinations are well known and conventional in the art for increased security in systems.

Therefore, using a PIN in addition to a biometric is an obvious expedient to increase security.

The Examiner also notes that de Sylva teaches that prior art systems use biometric and PINs for access (paragraph [0013]).

Re claim 14, the Examiner notes that it has been taught above and in the previous Office Action that the sample is received at one of a local database, remote database, portable storage device, host system, etc. as recited in the claim.

Re claim 15, a fingerprint scan, for example has been discussed above (see Black for example).

Re claim 16, as discussed above, Baer teaches the sample is associated with a preset transaction amount.

Re claim 18, Baer teaches a maximum transaction amount, as discussed above.

Re claim 19 and 20, Black teaches remote or local storing of the sample. Though silent to a government agency or third party security vendor, it would have been obvious to one of ordinary skill in the art to store the samples at such locations for enhanced security.

5. Claims 8, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Black/Baer as discussed above, in view of de Sylva.

The teachings of Black/Baer have been discussed above.

Black/Baer are silent to primary and secondary association.

De Sylva teaches primarily and secondarily associating different information with a sample based on preferences (30).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black/Baer with those of de Sylva.

One would have been motivated to do this in order to have convenience via customer preferences.

Re claim 16, de Sylva et al. teaches that a user can specify that transactions greater than a certain amount be charged to certain accounts while smaller purchases are charged to a different account (paragraph [0047]). Therefore it would have been obvious to have a preset amount for an account to control charges.

Re claim 17, de Sylva teaches associating more than one account, through user preference as discussed above.

6. Claims 8, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Black/Baer, as discussed above, in view of Moebs et al. (US 2005/0065872).

Black/Baer are silent to primary and secondary association.

Moebs et al. teaches primarily and secondarily associating different information with a sample based on preferences (paragraph [0017]).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black/Baer with those of Moebs et al.

One would have been motivated to do this in order to have overdraft protection.

Re claim 16, as Moebs teaches overdraft protection, the Examiner notes that as the biometric is associated with accounts, it would have been obvious that a preset transaction amount would be associated as well, such as a maximum value (for credit limits and initiating a line of credit).

Re claim 17, Moebs et al. teaches associating more than one account together for overdraft protection as discussed above.

Additional Remarks

7. The Examiner notes that PINs associated with biometrics are well known and conventional for increased security (versus just a biometric; see US 2001/0029493, 5,764,789, 2004/0084524, 2002/0174067, 2002/0062284, 2001/0018660, which show that a PIN and biometric can be used together, for additional security over just a PIN or biometric, for example). The Examiner also notes Royer et al. (US 2004/0155101) teaches the use of different biometrics with multiple accounts and Ramachandran (US 2001/0013551) and Pitroda (US 6,925,439) which teach consolidation of card accounts onto one card for convenience.

Additionally, Black (US 2005/0122209) teaches secondary security procedures for a sample as well (signature, sample, metrics, etc.).

The Examiner notes that different levels of security are well know and conventional in the art. For example, Deo et al. (US 5,721,781) teaches based on transaction amounts, different information is required in order to provide security/assurance that the user is valid (see Fig. 9), Rasmussen et al. (US 6,834,795) teaches similar teachings (FIG. 5), and Tetro et al. (US 6,095,413) teaches added security trough use of a separate databases).

Conclusion

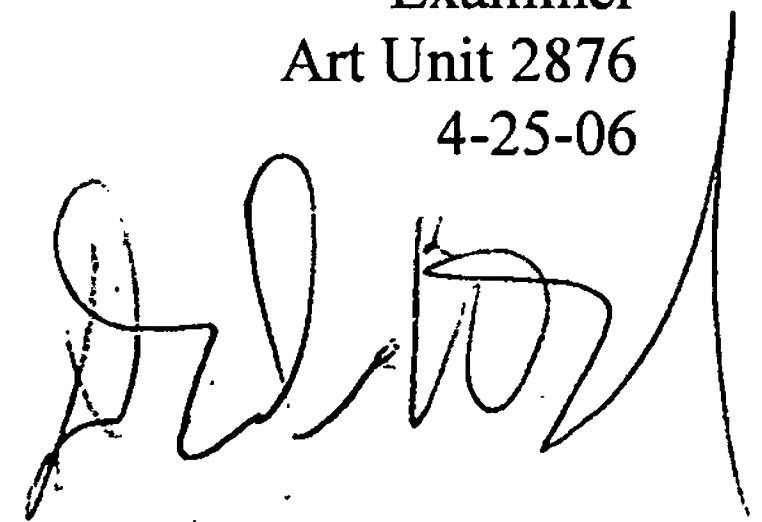
8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Deo et al. (US 5,721,781), Rasmussen et al. (US 6,834,795), and Tetro et al. (US 6,095,413), and Black (US 2005/0122209)

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel I. Walsh whose telephone number is (571) 272-2409. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel I Walsh
Examiner
Art Unit 2876
4-25-06

A handwritten signature in black ink, appearing to read 'D. Walsh', is written over the typed name and date.